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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,133	01/19/2001	Jonathan E. Lowthert	42390P10893	9485
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TROP PRUNER & HU, PC 8554 KATY FREEWAY SUITE 100 HOUSTON, TX 77024			EXAMINER RAMAN, USHA	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/766,133

Applicant(s)

LOWTHERT ET AL.

Examiner

Usha Raman

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED OFFICE ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3-6, 8-9, 11-18, and 21-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Zigmond (US Pat. 6,698,020).

In regards to claims 1, 9, 11 and 22, Zigmond discloses an advertisement insertion system (apparatus and method) for the selection of advertisement related to a program content according to an ad selection criteria and the insertion of the selected advertisement using triggers, which indicates the appropriate time (interruption point) for displaying a selected advertisement. Note column 15, lines 35-37, column 16, lines 34-37, and 40-41. Zigmond discloses that a predetermined agreement between an ad source and a programming source are specified by the ad selection criteria (information segment), containing ad parameters and ad selection rules. For example, an advertiser may specify that its advertisement is to be shown during a particular program regardless of what network it is broadcast on. Note column 12, lines 54-56. Zigmond further teaches providing explicit triggering events (interruption

point specifier) for use in cooperation with the ad selection criteria, to the ad insertion device. Note column 8, lines 55-58 and column 9, lines 5-8. The advertisement insertion device matches advertisement to identified program information contained in the program guide database, according to ad selection rules. The ad selection criteria (i.e. info segment) therefore comprises a content identifier, a plurality of ad entries, and each ad entry comprising interruption point specifier, as set by predetermined agreement between the programming and advertisement sources. Zigmond also teaches the step of an "info segment store" for storing the at least one info segment. Note column 11, lines 30-37. Zigmond discloses the step of selecting advertisement according to information contained in the program guide in order select advertisements relevant to the program content being watched by the viewer. Note column 11, lines 42-47, column 12, and lines 47-51. The system of Zigmond therefore anticipates the recited claims limitations, where the ad selection criteria (info segment) containing the "rules" of advertisement placements (ad entries) into program content (content identifier) according to explicit triggers (ad interruption specifier), which specifies when to interrupt a programming content to play the selected ad. The ad selection criteria further comprises the means for receiving from the receiver (ad insertion device) an information segment (ad selection criteria) request corresponding to the program identifier of a program being watched, and locating the information segment corresponding to the program identification (i.e.

information contained in a program guide), using the information contained in a program guide, and sending the info segment to the receiver.

In further regards to claim 11, step A, Zigmond discloses that program feed may come from live programming as well as from stored sources, such as videotapes. Note column 7, lines 9-12.

Method claims 13 and 14 contain the limitations of apparatus claim 1 and are therefore analyzed as previously discussed with respect to claim 1, above.

In regards to claims 3, and 21, Zigmond discloses that at the selected advertisement is displayed until termination and then the video switch is operative to resume the playing of the programming feed. Note column 17, lines 35-37. Therefore the ad entry further comprises a resuming indicator for actuating the video switch to resume the playback of the programming feed upon the completion of ad.

In regards to claims 4, 5, 15, 17, and 23, Zigmond discloses that the advertisements contain content ratings and parental lock codes for preventing certain types of ads (R-Rated) from being played but permitting other types of ads to be played (PG-Rated). Note column 10, lines 58-61 and column 13, lines 48-58. In further regards to claim 23, the predetermined characteristic for preventing ads from playing is the content rating.

In regards to claims 6 and 25, Zigmond discloses that ad selection criteria can be modified for content with increased subscription fees, which allows the viewer to forego the advertisements all together. Note column 14, lines 30-33. The info segment therefore contains an "ad lock" specifier for disabling the play of ads (i.e. skipping the interruption point) during increased subscription services.

In regards to claim 12, Zigmond discloses the ad entry of one of the info segments further comprising at least one of a resume indicator, ad lock specifier, and permitted/prohibited ad type specifier, as discussed in claims 3-6, above.

In regards to claim 8, Zigmond discloses means for generating initial ad selection rules of ad selection criteria (info segments) predefined by advertisers and modifying it based on user response, etc. Note column 11, lines 50-65 and column 12, lines 9-15 and lines 44-51.

In regards to claim 16, Zigmond discloses that the permission and prohibition of advertisements are based on content ratings (example, PG, R rated contents) and parental locks. Note column 13, lines 48-58. Content ratings are indicative of characteristics such as language content, sexual content, violence, etc. present in content, therefore Zigmond comprises the method of prohibiting a content based on the presence of language, sexual content, violence, etc.

In regards to claims 18 and 24, Zigmond discloses the method of simultaneously broadcasting a selected advertisement on all television channels. Such a transmission ignores the content identifier in the information segment, since it is broadcast in all channels, regardless of the program content being

watched, and is therefore a null content identifier. The information segment in this case is implicitly associated with each of the content item because for each of the content item, only that advertisement is played.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 7, 10, 19-20, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond (US Pat. 6,698,020) in view of Gadkari (US Pat. 2002/0078443).

In regards to claims 2 and 26, Zigmond does not disclose using maximum interrupt specifier during the interruption of program content. Gadkari discloses the use of a trigger suppression (maximum interrupt specifier) in an ad insertion system, when the secondary content being inserted has a longer presentation time than the interval of the original content (the available time window). Note paragraph 57, in page 5. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Zigmond to include a trigger suppression field as taught by Gadkari in order to force the termination of the presentation of an advertisement (i.e. enable premature termination of an advertisement), when it has reached its "allotted", specified amount of presentation time.

In regards to claims 7, and 10, Zigmond discloses the add entries recited in steps (c)-(f), as discussed in claims 3-6, above. Zigmond however, lacks the recite the limitations of a maximum interruption length specifier, recited in step (b). Gadkari discloses the use of trigger suppression (maximum interrupt specifier) in an ad insertion system, when the secondary content being inserted has a longer presentation time than the available time window. Note paragraph 57, in page 5. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Zigmond to include a trigger suppression field as taught by Gadkari in order to force the termination of the presentation of an advertisement (i.e. enable premature termination of an advertisement), when it has reached its "allotted", specified amount of presentation time.

In regards to claim 19, see claims 4, 2, and 6. In further regards to claim 19, the advertisement is skipped based on the criterion of a subscription level.

In regards to claim 20, the modified system of Zigmond in view of Gadkari discloses the use of ad lock for subscribers with increased subscription fees. Note column 14, lines 28-33. Official Notice is taken that purchasing multimedia content has a higher subscription privileges and higher subscription fees than renting the content. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the ad lock feature to users who have purchased a product (with a higher subscription fee) rather than rented it, in order



to provide the users an increased privileges and access for purchasing the content.


***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Reynolds (US Pre Grant Pub. 2004/0168189) discloses an advertisement insertion system where an advertisement control information ("info segment") identifies the time, length, condition for advertisements to be played at, as well as the program id or network id the advertisement must be associated with (see abstract). Carver et al. (US Pre Grant Pub. 2004/0015986) discloses an advertisement insertion system for inserting advertisements into stored media that also addresses the problem of stale advertisements in recorded programs. The system utilizes a content import component including advertisements and related data for associating advertising content with program content (see paragraph 2 in page 1, and paragraphs 90-92 in page 7).
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usha Raman whose telephone number is (703) 305-0376. The examiner can normally be reached on Mon-Fri: 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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